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-- REMARKS --

The §112 rejections

The §112 rejections are traversed.

Claims 25, 37, and 46 were rejected as indefinite. The Examiner alleges that either the Examiner or one skilled in the art would not know how the step of determining availability and the step of determining capability would be accomplish [sic], and requests the Applicant to point out columns and lines demonstrating how these steps could be achieved.

Respectfully, the Applicants direct the Examiner's attention to pages 6-11 of the specification, and FIG. 3. For example, the paragraph starting at page 6, line 23 describes the embedded device, and the paragraph beginning on page 7, line 10 describes the portable network access device. In another example, the paragraph starting on page 7, line 22 describes the link between the embedded device and portable network access device. Applicants further note that §112 requires only that the claims set out and circumscribe the invention with a reasonable degree of precision and particularity. The definiteness of the language must be analyzed, not in a vacuum, but in light of the teachings of the disclosure as it would be interpreted by one of ordinary skill in the art. See, MPEP §2106.

Additionally, the Examiner's objections to claims 25, 37, and 46 are traversed. The Examiner is respectfully directed to the text of the claims. Applicants intentionally claim "and" – Applicants intentionally do not claim "or." Applicants appreciate the Examiner's citations from their specification, and request that the Examiner consider the claims, not in a vacuum, but in light of how the claims would be interpreted by one of ordinary skill in the art.

The claimed method requires determining both the availability (see the 'determining availability' clause) *and* capability (see the 'determining capability' clause) of *both* the at least one embedded device and the at least one portable network device, prior to initiating a connection based on the determined capability. The Examiner's proposed modifications would change the invention, and modify the scope of the claims.

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Furthermore, the Examiner's explanation of the objection rings hollow. Specifically, the Examiner appears to be confused by the description at page 9, lines 5-7, "determining if a more reliable service is available on a portable network access device (PNAD) 245 than the service provided on the embedded device 205." The Examiner construes this statement as determining one *or* the other, but does not explain how a determination of reliability can be made *without determining both*. The Examiner also cites to FIG. 3 as causing uncertainty, but fails to indicate how an embedded device can be used if the embedded device is not available. Additionally, FIG. 3 illustrates an embodiment of a method 300 to determine if a more reliable service is available on a portable network device than the service provided on the embedded device – method 300 is determining if the network access is better on the portable network device than the embedded device and therefore uses the embedded device as the base – method 300 essentially presumes the availability of the embedded device.

Withdrawal of the §112 rejections and objections is requested.

The §102(e) rejections

Claims 25, 34, 37 and 46 were rejected as anticipated by Yamashita. This rejection is traversed.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the . . . claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Thus, to warrant the §102(e) rejection, the references cited by the Examiner must show each and every limitation of the claims in complete detail. The Applicants respectfully assert that the cited references fail to do so.

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Yamashita does not disclose "initiating a connection to the network using one of the at least one embedded device or at least one portable network access device based on the capability determination". At most, Yamashita discloses determining whether to connect to a network using a first or second radio communication section (radio communication sections 1, 2) based on a determination of whether the vehicle is in "high speed transit". See ¶ 34, Yamashita.

Yamashita discloses two devices for "connecting to a network": radio communication section 1 is "a communication system not warranting communication capability when in fast transit, preferably means of communication which makes possible connection to a cordless system such as PHS" and radio communication section 2 is "a communication system warranting communication when in fast transit, preferably means of communication such as a portable telephone." See ¶29, Yamashita.

In view of these two communication systems, Yamashita notes that if the bearer, while riding a vehicle, stands by or initiates a call via the cordless system, the conversation may be interrupted when the vehicle accelerates beyond a certain speed. See ¶7, Yamashita. In view of this possibility, Yamashita attempts to provide an apparatus for mobile communications capable of automatically accessing the most suitable system for intended communication, and a system capable of automatically forbidding access to any communication system unsuitable for communication during high speed transit. See ¶9-10, Yamashita. Additionally, Yamashita discloses that the apparatus includes a control section to judge whether communication during high speed transit is possible, and if possible, forbids a radio communication section communicating with a system inappropriate for communication during high speed transit from standing by or initiating a call. See ¶11, Yamashita.

In distinct contrast, claims 25, 37, and 46 require initiating a connection to the network using one of the at least one embedded device or at least one portable network access device based on the capability determination. Claims 25, 37, and 46 do not claim initiating the connection based on the speed of the vehicle (i.e. in high speed transit), but rather based on the determined capability.

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Claim 34 depends directly from claim 25, and is therefore not anticipated by Yamashita for at least the same reasons.

Withdrawal of the rejections to claims 25, 34, 37, and 46 is requested.

The §103(a) rejections

The §103(a) rejections of claims 26, 33, 35, 38, and 45 as unpatentable over Yamashita are traversed.

Claims 26, 33 and 35 depend directly from claim 25, and are therefore not unpatentable over Yamashita for at least the same reasons as claim 25. Claims 38 and 45 depend directly from claim 37, and are therefore not unpatentable over Yamashita for at least the same reasons as claim 37.

The §103(a) rejections of claims 27-32 and 39-44 as unpatentable over Yamashita in view of Khullar are traversed. Claims 27-32 depend directly from claim 25, and are therefore not unpatentable over Yamashita in view of Khullar for at least the same reasons as claim 25. Claims 39-44 depend directly from claim 37, and are therefore not unpatentable over Yamashita in view of Khullar for at least the same reasons as claim 37.

Additionally, there is no motivation to combine Yamashita with Khullar. The mere fact that Yamashita can be modified in view of Khullar to obtain the claimed invention (which Appellants deny) does not render the resultant modification obvious unless the prior art also suggests the desirability of the combination. See, *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). The Examiner's cited motivation, "to determine the ability to make a connection or service, and make the communication more reliable and efficient" fails to note exactly where either reference makes such a suggestion.

The §103(a) rejections of claim 36 as unpatentable over Yamashita in view of Holmstrom is traversed. Claim 36 depends directly from claim 25, and are therefore not unpatentable over Yamashita in view of Holmstrom for at least the same reasons as claim 25.

Withdrawal of the rejections to claims 26-33, 35-36, and 38-45 is requested.

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CONCLUSION

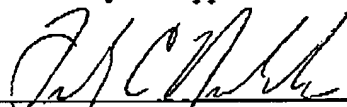
The Applicants respectfully submit that claims 25-46 fully satisfy the requirements of 35 U.S.C. §§102, 103 and 112. In view of the foregoing, favorable consideration and early passage to issue of the present application is respectfully requested.

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Respectfully submitted,
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